

EPARTMENT OF COMMERCE **Patent and Trademark Office**

COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231 Address:

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR			ATTORNEY DOCKET NO.
08/870,585	06/06/97	SULLIVAN		М	SLD-2-035-3-
Г	- QM12/0628			EXAMINER	
DIANE F. COVELLO, ESQ.				GRAHAM, M	
DIVISION PA	IVISION PATENT AND TRADEMARK COUNSEL PALDING SPORTS WORLDWIDE 25 MEADOW STREET P.O. BOX 901			ART UNIT	PAPER NUMBER
				3711	97
CHICOPEE M				DATE MAILED:	2 n6/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



Office Action Summary

Application No. 08/870,585

on No. Applic

Examiner

Mark S. Graham

Group Art Unit 3711

Sullivan

X Responsive to communication(s) filed on Apr 10, 2000	
☐ This action is FINAL .	
Since this application is in condition for allowance except in accordance with the practice under Ex parte Quayle, 19	
A shortened statutory period for response to this action is see is longer, from the mailing date of this communication. Failur application to become abandoned. (35 U.S.C. § 133). Exter 37 CFR 1.136(a).	re to respond within the period for response will cause the
Disposition of Claims	
	is/are pending in the application.
Of the above, claim(s)	is/are withdrawn from consideration.
☐ Claim(s)	is/are allowed.
	is/are rejected.
☐ Claim(s)	is/are objected to.
☐ Claims	
Application Papers	
☐ See the attached Notice of Draftsperson's Patent Draw	ving Review, PTO-948.
The drawing(s) filed on is/are obj	ected to by the Examiner.
☐ The proposed drawing correction, filed on	is 🗀 approved 🗀 disapproved.
$\hfill\Box$ The specification is objected to by the Examiner.	
\square The oath or declaration is objected to by the Examiner.	
Priority under 35 U.S.C. § 119	
Acknowledgement is made of a claim for foreign priori	ity under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies	s of the priority documents have been
☐ received.	
\square received in Application No. (Series Code/Serial N	lumber)
\square received in this national stage application from t	he International Bureau (PCT Rule 17.2(a)).
	·
☐ Acknowledgement is made of a claim for domestic price	ority under 35 U.S.C. § 119(e).
Attachment(s)	
☐ Notice of References Cited, PTO-892	
Information Disclosure Statement(s), PTO-1449, Paper	No(s)
☐ Interview Summary, PTO-413	040
□ Notice of Draftsperson's Patent Drawing Review, PTO	-340
□ Notice of Informal Patent Application, PTO-152	
SEE OFFICE ACTION O	N THE FOLLOWING PAGES

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The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Nesbitt in view of Nakamura for the reasons set forth in the previous action.

In response to applicants remark entitled A.1. the examiner responds as follows:

The applicant is claiming a low acid material. Applicant states that Nesbitt discloses a low acid material. Applicant's argument merely bolsters that of the examiner.

In response to applicants remark entitled A.2. the examiner responds as follows:

Nakamura discloses the claimed material having an acid content of less than 16%. It is irrelevant whether Nakamura distinguishes between "low" and "high" acid as defined by applicant. Applicant has claimed that the acid content be "no more than 16%". Nakamura's material meets this limitation. If applicant's material is "low acid" when it is 16% or less than Nakamura's material is "low acid" when it is 16% or less. Again it would appear that applicant's remarks merely bolster the examiner's argument.

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In response to applicants remark entitled A.3. the examiner responds as follows:

Even assuming arguendo that Nakamura does not disclose a "high acid" ionomer the point is irrelevant as the applicant is claiming a "low acid" ionomer.

In response to applicants remark entitled A.4. the examiner responds as follows:

Again applicant is claiming a low acid ionomer and not a high acid ionomer. However, "commercial availability" is not a condition of patentablity.

In response to applicants remark entitled A.5. the examiner responds as follows:

Note Nesbitt at Col. 3, lines 16-25. Regarding the modulus, Nesbitt teaches that the inner layer modulus should be relatively high while that of the outer layer should be relatively low. The ranges claimed by the applicant are within those commonly known for golf ball cover materials and absent a showing of criticality are not considered unobvious.

In response to applicants remark entitled A.6. the examiner responds as follows:

No nexus has been shown between the alleged commercial success and the particularly claimed features of the ball of claims 1-8.

Claims 1-6 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-8 of copending Application No. 08/920,070. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application

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since the referenced copending application and the instant application are claiming common subject matter, as follows: a golf ball with a hard inner and soft outer layer.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The information disclosure statement filed 3/27/00 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). The information disclosure statement filed 3/27/00 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). The information disclosure statement filed 3/27/00 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG June 27, 2000

> Mark S. Graham Primary Examiner